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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,755	11/15/2001	Lawrence M. Boyd	4002-2729	8631
7590	07/13/2004			
Kenneth A Gandy Woodard Emhardt Naughton Moriarty & Mcnett Bank One Center Tower Suite 3700 111 Monument Circle Indianapolis, IN 46204-5137			EXAMINER COMSTOCK, DAVID C	
			ART UNIT 3732	PAPER NUMBER

DATE MAILED: 07/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

28

Office Action Summary	Application No. 09/869,755	Applicant(s) BOYD ET AL.	
	Examiner David Comstock	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Allowable Subject Matter

The indicated allowability of claims 35-37 is withdrawn in view of the rejections set forth below. Accordingly, the finality of the last action is withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 35-42 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Bianchi et al. (6,033,438; cited by applicant on 15 September 2003).

The applied reference has a common assignee and at least one common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of

this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Bianchi et al. disclose a spacer insertion tool 800 comprising a housing 805, a shaft 815, and an occlusion member 820. (See Figures 24-36 and col. 15, line 23 - col. 16, line 48) The housing has a proximal end 806 and an opposite distal end 807 defining a passageway 810 between the proximal and distal ends. The shaft has a first end 816 and an opposite second end 817. The shaft is threadably disposed within the passageway with the first end adjacent the distal end of the housing. The first end defines a spacer engager 819. The occlusion member is extendible from the distal end of the housing for blocking an opening defined in a spacer 500, 550 when said spacer engager is engaged to the spacer. The occlusion member has a plate 821 with curved interior and exterior surfaces 825. The curved exterior surface approximates the outer surface of a spacer when the spacer engager is engaged to a spacer and the occlusion member is blocking the opening of the spacer. The plate defines a groove 822. The groove is disposed around a fastener 830 so that the plate is slidable relative to the housing. The spacer includes a threaded post 818 or optionally a pair of prongs configured to grasp a spacer (see col. 15, lines 50-52).

Claims 35-42 are rejected under 35 U.S.C. 102(e) as being anticipated by clearly anticipated by Bianchi et al. (2004/0073309).

The applied reference has at least one common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e)

might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Bianchi et al. disclose a spacer insertion tool 800 comprising a housing 805, a shaft 815, and an occlusion member 820. (See Figures 24-36 and paragraphs 0114 - 0121) The housing has a proximal end 806 and an opposite distal end 807 defining a passageway 810 between the proximal and distal ends. The shaft has a first end 816 and an opposite second end 817. The shaft is threadably disposed within the passageway with the first end adjacent the distal end of the housing. The first end defines a spacer engager 819. The occlusion member is extendible from the distal end of the housing for blocking an opening defined in a spacer 500, 550 when said spacer engager is engaged to the spacer. The occlusion member has a plate 821 with curved interior and exterior surfaces 825. The curved exterior surface approximates the outer surface of a spacer when the spacer engager is engaged to a spacer and the occlusion member is blocking the opening of the spacer. The plate defines a groove 822. The groove is disposed around a fastener 830 so that the plate is slidable relative to the housing. The spacer includes a threaded post 818 or optionally a pair of prongs configured to grasp a spacer (see paragraph 0116, lines 12-15).

Claims 35-42 are rejected under 35 U.S.C. 102(e) as being anticipated by clearly anticipated by Bianchi et al. (6,695,882).

The applied reference has a common assignee and at least one common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Bianchi et al. disclose a spacer insertion tool 800 comprising a housing 805, a shaft 815, and an occlusion member 820. (See Figures 24-36 and col. 15, line 35 - col. 16, line 57) The housing has a proximal end 806 and an opposite distal end 807 defining a passageway 810 between the proximal and distal ends. The shaft has a first end 816 and an opposite second end 817. The shaft is threadably disposed within the passageway with the first end adjacent the distal end of the housing. The first end defines a spacer engager 819. The occlusion member is extendible from the distal end of the housing for blocking an opening defined in a spacer 500, 550 when said spacer engager is engaged to the spacer. The occlusion member has a plate 821 with curved interior and exterior surfaces 825. The curved exterior surface approximates the outer surface of a spacer when the spacer engager is engaged to a spacer and the occlusion member is blocking the opening of the spacer. The plate defines a groove 822. The groove is disposed around a fastener 830 so that the plate is slidable relative to the housing. The spacer includes a threaded post 818 or optionally a pair of prongs configured to grasp a spacer (see col. 15, lines 61-63).

Claims 35-42 are rejected under 35 U.S.C. 102(e) as being anticipated by clearly anticipated by Bianchi et al. (6,409,765).

The applied reference has a common assignee and at least one common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Bianchi et al. disclose a spacer insertion tool 800 comprising a housing 805, a shaft 815, and an occlusion member 820. (See Figures 24-36 and col. 15, line 36 - col. 16, line 62) The housing has a proximal end 806 and an opposite distal end 807 defining a passageway 810 between the proximal and distal ends. The shaft has a first end 816 and an opposite second end 817. The shaft is threadably disposed within the passageway with the first end adjacent the distal end of the housing. The first end defines a spacer engager 819. The occlusion member is extendible from the distal end of the housing for blocking an opening defined in a spacer 500, 550 when said spacer engager is engaged to the spacer. The occlusion member has a plate 821 with curved interior and exterior surfaces 825. The curved exterior surface approximates the outer surface of a spacer when the spacer engager is engaged to a spacer and the occlusion member is blocking the opening of the spacer. The plate defines a groove 822. The groove is disposed around a fastener 830 so that the plate is slidable relative to the

Art Unit: 3732

housing. The spacer includes a threaded post 818 or optionally a pair of prongs configured to grasp a spacer (see col. 15, lines 63-65).

Claims 35-42 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Bianchi et al. (WO 98/55052; cited by applicant on 15 September 2003).

Bianchi et al. disclose a spacer insertion tool 800 comprising a housing 805, a shaft 815, and an occlusion member 820. (See Figures 24-36 and page 29, line 16 - page 32, line 4) The housing has a proximal end 806 and an opposite distal end 807 defining a passageway 810 between the proximal and distal ends. The shaft has a first end 816 and an opposite second end 817. The shaft is threadedly disposed within the passageway with the first end adjacent the distal end of the housing. The first end defines a spacer engager 819. The occlusion member is extendible from the distal end of the housing for blocking an opening defined in a spacer 500, 550 when said spacer engager is engaged to the spacer. The occlusion member has a plate 821 with curved interior and exterior surfaces 825. The curved exterior surface approximates the outer surface of a spacer when the spacer engager is engaged to a spacer and the occlusion member is blocking the opening of the spacer. The plate defines a groove 822. The groove is disposed around a fastener 830 so that the plate is slidable relative to the housing. The spacer includes a threaded post 818 or optionally a pair of prongs configured to grasp a spacer (see page 30, lines 8-10).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

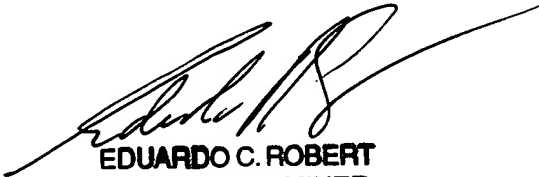
Claims 35-37 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 48-50 of copending Application No. 10/699,175 (2004/0073309). Although the conflicting claims are not identical, they are not patentably distinct from each other because the additional limitation of claim 35 (of the present application), i.e. the occlusion member with a curved surface, which is not found in claim 48 (of the '175 application), is fully disclosed in claim 50 (of the '175 application). Claim 50, which depends from claims 49 and 48, also discloses the limitations of claims 36 and 37. Claim 36 corresponds to claim 49 and claim 37 corresponds to claim 50. Since claims 35-37 are anticipated by claims 48-50, they are not patentably distinct therefrom. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Comstock whose telephone number is (703) 308-8514.

DC

D. Comstock
02 July 2004



EDUARDO C. ROBERT
PRIMARY EXAMINER